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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/465,506  | 12/16/1999  | LANCE LUNDBERG       | ICON-102            | 8959             |
| 909   | 7590        | 02/23/2005           | EXAMINER            |                  |
| PILLSBURY WINTHROP, LLP<br>P.O. BOX 10500<br>MCLEAN, VA 22102 |             |                      | PATEL, JAGDISH      |                  |
|   |             |                      | ART UNIT            | PAPER NUMBER     |
|   |             |                      | 3624                |                  |

DATE MAILED: 02/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/465,506

Applicant(s)

LUNDBERG ET AL

Examiner

JAGDISH PATEL

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11/4/05.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 30-40 is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12/16/99 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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## **DETAILED ACTION**

1. This communication is in response to amendment filed 11/4/04.

### ***Response to Amendment***

2. Claims 1,2,6, 18 and 30 have been amended.

### ***Response to Arguments***

3. Rejection of claims 30-40 as cited in prior office action have been withdrawn. However, the amendment did not overcome rejection under 35 USC 112(second) of claims 1-29 and 35 USC 101 (claims not within technological arts) of claims 1-17. See explanation below.

### ***Claim Objections***

4. Claim 18 recites preamble which recites "...comprising in at least one server interfacing with at least one server" is in improper format. The preamble should either indicate that the network comprises at least one server and at least one client and should end with phrase "comprising" or following the word "comprising" in the present form and including the server and the at least one client within the body of the claim. Appropriate correction is required. (se 608.01(i)and 37 CFR 1.75.)

## **Allowable Subject Matter**

- 4.1 Claims 30-40 are allowed.

### ***Claim Rejections - 35 USC § 112***

5. Claims 1-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point

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out and distinctly claim the subject matter which applicant regards as the invention.

6. Common to all aforementioned claims 1-17 are the following defects:

As an example, claim 1 recites, in the preamble, the method as steps as being programmed (presumably on the server). However, the body of the claim suggests that the steps are carried out by a trading company and not by the server of the computer system. Therefore, the claim(s) do not clearly indicate that the method steps are performed on the server. Secondly, the computer system comprises the storage devices storing data bases, files, program routines and a communication network. However, none of these components have any relationship to the recited method steps. The claims are therefore, ambiguous, with regard to technological implementation. Appropriate correction is required to resolve this defect.

Similar analysis also renders claims 2-17 unclear and indefinite.

7. Claims 1-5 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP §.2172.01. The omitted steps are:

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Amended claim 1 recites determining a cash finance component in step b). Note that the limitation "providing financing" and the "financing includes CSC-desired trade products from the TC inventory database..trade-credit portion" are recited only as intended use of ("for the purpose of") the cash finance component. Therefore, no patentable weight is accorded to this limitation. The claim fails to recite any relationship of the determining of the cash finance component to the TC receiving securities from the CSC step c) and the TC receiving at least a portion of the cash/trade-credit blend from the CSC.

Step c) recites that the TC receives securities from the CSC in exchange for the trade-credit portion of the cash/trade-credit blend. However, the claim fails to recite any communication of the cash/trade-credit blend from the TC to the CSC. This comment also applies to step d).

Step d) recites that the TC receives at least a portion of the cash/trade-credit blend from the CSC. However, the claim fails to recite any communication of the cash/trade-credit blend from the TC to the CSC.

8. The claim in the present form contain at least the following defects in view of the foregoing discussion.
  - 1) relationship of the cash finance component (step b) is recited as for intended purpose (i.e. function) of providing financing. There is no correlation made of the cash finance component to any other steps i.e. steps c) or d). In other words receiving securities and receiving at least a portion of the cash/trade-credit blend are performed regardless of whether the cash finance component is determined or not.
  - 2) similarly, relationship of the inventory database which identify "suitable trade products" (step a) to steps c) and d) can not be established because limitation "a trade

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credit finance component of a cash/trade-credit package as desired by a deficient asset CSC" is not a functional limitation and not given any patentable weight. In other words this description does not, in any way, further limit the step of maintaining the "inventory data base" for identifying suitable products. In view of this defect, it is asserted that there is the relationship of step a) to steps i.e. steps c) and/or d) is unclear. Note that step d) requires "a portion of the cash/trade-credit blend from the CSC".

9. Limitations c) and d) are also require active steps (i.e. positively reciting as a method step) of generating the cash/trade-credit blend, the cash/trade-credit blend finance package and the TC trade-credit portion, and securities recited in step c).

Claim 1 further recites that the method is implemented in a computer system which comprises the programmed steps of the claimed invention including steps c) and d). It is not conceivable that a computer can be programmed to receive a documents such as securities and "at least a portion of the cash/trade-credit blend from the CSC". Note that a computer can only communicated data or information representing securities and the portion as recited steps c) and d). Appropriate correction is required.

10. Claims 18-29 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential structural cooperative relationships of elements, such omission amounting to a gap between the necessary structural connections. See MPEP § 2172.01. The omitted structural cooperative relationships are:

- (1) the computer processor means for processing select data not structurally connected to elements recited in (b)-(g). This renders the claim unclear as to which data storage the processor is connected and responsive to. It is recommended that limitation (b) should be changed to read "the storage device".

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- (2) element (b) "means for storing data on storage device" recites "for the processing of a basis of...for trade products from TC" as intended use of the data. Such "non-functional data" do not change the functionality of the recited means because it does not further define the stored data. In this case the non-functional data do not change the function of "means for storing data on a storing device".

It is recommended that a limitation "...means for processing (and/or storing) cost basis of a cash/trade-credit.." be added to resolve this defect.

In absence of the aforementioned missing elements, there is not sufficient antecedent basis for limitation "cost basis" in step © because no element (i.e. means for) is recited that stores or calculates this parameter in the storage device.

The term "as stored in the same or a different storage device" renders the claim indefinite because the claim does not refer to storing in "same or a different device".

#### ***Claim Rejections - 35 USC § 101***

10. Claims 1-17 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

#### **(claims 1-17 are not within technological arts)**

Please refer to prior office action for detailed background that forms basis for rejection of claims under technological art requirement.

In the present application, Claims 1-17 have no connection to the technological arts. Contrary to the recitation of the preamble, none of the steps indicate any connection to a computer or technology. As an example, steps a) - d) are explicitly recited as being performed by a trading company (i.e. a representative or an employee of the TC). Furthermore, absence of any technological implement recited in the claim leads to interpretation that these steps and therefore the entire claimed invention could be performed manually. Therefore, the claims are not within technological arts and hence directed towards non-statutory subject matter. To overcome this rejection the Examiner recommends that Applicant amend the claims to better clarify which of the steps are being performed within the technological arts, such as the process of the method performed based on application of a computer processor / communication network etc. All other claims could

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be similarly amended to include a computer and/or a communication network as appropriate within the scope of the disclosure.

See pertinent analysis under 35 USC 112(second) rejection of these claims.

### **Conclusion**

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAGDISH

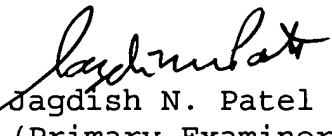


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PATEL whose telephone number is (703)308-7837. The examiner can normally be reached on 800AM-600PM M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached on (703)308-1065. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Jagdish N. Patel  
(Primary Examiner, AU 3624)  
2/17/05